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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,366

Applicant(s)

HAINES ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Continued Examination

The examiner is in receipt of applicants responses to office action mailed 5/9/2003. The response is contained in amendment D and E. E being the response to a non-responsive communiqué mailed 10/30/2003. Acknowledgement is made to the addition of claims 21-24. Applicant's arguments have been carefully considered and were found to be persuasive, therefore, the following new grounds of rejection are provided below.

Copy of Provisional Application(s) Relied Upon for Prior Art Effect May Not be Supplied.

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the

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provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant claims an extended data interface (EDI). Since the term was not described in the specification the examiner looked to Microsoft's Computer dictionary for a definition, which described (EDI) "Electronic data interchange" as a standard for exchanging bundles. This definition did not seem to be consistent with the applicant's EDI. The examiner also searched the web and could not find a definition of the term, for this reason the examiner for the purpose of examination will define the term (EDI) as a printer cable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al (US 202/0065950).

In regards to claim 1, Katz discloses a consumable order assistance system for computer peripheral devices, comprising:

a personal computer having a web browser and a messaging system (page 5, para 69);

at least one computer peripheral device having a messaging system (page 5, para 69);

a communication link signal coupling the personal computer with a seller of a consumable for the computer peripheral device via the web browser (page 5, para 69);
and

a consumable order assistance computer program provided on the personal computer (page 8, para 100, Peripheral interface agent (PIA)) and

configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable (page 8, para 100), alert a user of the personal computer of the notification (page 5, para 69), and provide an order location to the user for the consumable (page 5, para 69).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Official Notice.

In regards to claim 2, Katz teaches wherein the consumable order assistance computer program is further configured to collect a series of notifications and summarize the series of notifications for one or more computer peripheral devices (page 5, management of devices). Applicant may, however, argue that the system of Katz does not specifically mention that there is a summary of the notifications. It was old and well known in the art at the time of the invention to collect and list notifications. It would have been obvious to a person having ordinary skill in the art to include in Katz listing a summary of notices, because this would improve the system of

Katz by placing the requirements of paper toner and other supplies along with software needs (page 5, para 69) all in one convenient list for purchase which is commonly referred to as a shopping cart or invoice.

In regards to claim 3, Katz teaches wherein the consumable order assistance computer program consolidates a plurality of notifications from the at least one computer peripheral device (see response to claim 2).

In regards to claim 4, Katz teaches wherein the consumable order assistance computer program is further configured to request identification from a user to verify authorization of the user to submit an order (page 3, para 32, interactive processing of transaction, locate subscriber account). Applicant may, however, argue that the system of Katz does not specifically mention that the user is prompted for identification to authorize a purchase. It was old and well known in the art at the time of the invention to identify and authorize a user before a transaction is completed. It would have been obvious to a person having ordinary skill in the art to include in Katz the identification and authorization of a user, because if this was not done then an unauthorized transaction might take place which the user may refuse to pay for, thus having the company loose money by providing product that was not authorized.

In regards to claim 5, Katz teaches wherein the consumable order assistance computer program is further configured to request at least one level of authorization

from a user before sending an order via the communication link to a reseller of the consumable (see response to claim 4 and page 29, para 667, present pages to an interactive user and gather data from him or her).

In regards to claim 6, Katz teaches wherein the consumable order assistance computer program is further configured to request at least one level of authorization from a user before sending an order via the communication link to a reseller of the consumable (see response to claims 4 and 5)

In regards to claim 7, Katz teaches wherein the consumable order assistance computer program is further configured to prompt a customer user for authorization information (see response to claims 4-6).

In regards to claim 8, Katz teaches wherein the communication link comprises an electronic communication link that enables the consumable order assistance computer program to submit an e-mail order (page 6, para 77). Applicant may argue, however that Katz does not specifically mention that the order is being submitted via e-mail. It was old and well known at the time of the invention to use e-mail to communicate purchase orders. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Katz using e-mail to submit an order, because this would offer the user another means for conducting a transaction

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which would allow the user to make an order if other forms of e-commerce were not available, thus assuring to some degree that the sale was not lost.

In regards to claim 9, Katz teaches an e-commerce system for ordering peripheral device components, but does not specifically mention that the ordering is done using a facsimile. It was old and well known in the art at the time of the invention to use facsimile machines to place orders. It would have been obvious to a person having ordinary skill in the art to include in Katz placing orders by facsimile, because this would give people not connected to the Internet the capability to order the parts, thus saving a sale by providing the consumer a means to order the required parts.

In regards to claim 10, Katz discloses a computer-implemented system which implements a program in which consumable components of computer peripheral devices are replenished, the system comprising:

a notification system that alerts a user of a personal computer that they need to order a consumable for a computer peripheral device associated with the personal compute;

a facilitation system that provides a communication link with a reseller of the consumable; and

at least one from a list of a consolidation system for consolidating a plurality of orders,

an authorization system for confirming that a user is authorized to place an order for the consumable, and

an order assistance system that places an order for the consumable (see response to claims 1-9).

In regards to claim 11, Katz teaches ordering device components over the Internet, but does not specifically mention that the items presented for order have a part number. It was old and well known at the time of the invention to identify parts to be ordered using a part number. It would have been obvious to a person of ordinary skill in the art to include in Katz providing a part number, because this is a notoriously well known way of identifying parts and would provide a means for assuring that the correct part was ordered.

In regards to claim 12, Katz teaches wherein the notification system comprises a messaging system within an embedded web server of a computer peripheral device and a messaging system within a personal computer (page 5, para 67).

In regards to claim 13, Katz teaches wherein the personal computer further comprises a browser, and the messaging system comprises

an e-mail application (page 6, para 77),

Katz teaches sending information to a user to purchase an item (para 67,68 and 87, prompting the user to conduct a transaction), but does not specifically mention that

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the information is provided by email. It was old and well known at the time of the invention to use email to provide information such as alerts. It would have been obvious to person of ordinary skill in the art to include in Katz emailing information to the user, because this would provide an effective means for sending information and not interrupting the user who may be working on something else and not be pleased with a sudden interruption by some manufacturer trying to sell a consumable.

In regards to claim 14, Katz teaches wherein the e-mail notification identifies the consumable by a part number (see response to claims 11 and 13).

In regards to claim 15, Katz teaches wherein the system comprises the consolidation system configured to aggregate a plurality of notifications for one or more computer peripheral devices (see response to claim 2).

In regards to claim 16, Katz teaches wherein the system comprises the authorization system configured to request authorization from a user prior to automatically submitting an order for the consumable to a reseller of the consumable (see response to claims 4 and 5).

In regards to claim 17, Katz teaches wherein the system comprises the order assistance system configured to automatically submit an order for the consumable in

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response to receiving a notification that a consumable needs to be ordered (page 28, para 618, non-interactive).

In regards to claim 18, Katz discloses a method of providing order assistance, comprising:

- providing a computer peripheral device,
- a personal computer having a communication link with a reseller of a consumable, and
- a messaging system extending between the computer peripheral device and the personal computer;
- detecting a need to replenish a consumable at the computer peripheral device;
- notifying a user at the personal computer of the need to replenish the consumable;
- providing an order address location to a user for a reseller that sells the consumable; and
- placing an order for the consumable with the reseller using the personal computer (see response to 1-17 and e-commerce URL).

In regards to claim 19, Katz teaches wherein placing the order comprises automatically placing the order for the consumable in response to notifying the user (page 5, para 68).

In regards to claim 20, Katz teaches wherein, prior to placing an order, querying a user to authorize placing the order with an identified reseller (see response to claims 4,5 and 6).

In regards to claim 21, Katz discloses a consumable order assistance system for computer peripheral devices, comprising:

- a personal computer having a web browser and a messaging system (see response to claim 1);

- at least one computer peripheral device having a messaging system (see response to claim 1);

- a bi-directional communication link signal coupling the personal computer with a seller of a consumable for the computer peripheral device via the web browser (page 6, para 78),

- the bi-directional communication link configured to enable a user to interact with the computer peripheral device to obtain information on a consumable for one computer peripheral device including at least one of consumable levels, media levels and types, warnings, notifications, job assurance, and printer capabilities (page 6, para 78 and page 5, para 67);

- a consumable order assistance computer program provided on the personal computer and configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable, alert a user of the personal

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computer of the notification, and provide an order location to the user for the consumable (see response to claims 1-20); and

a server communicating with one of the personal computer and the at least one computer peripheral device (page 5, para 67) and

including a centralized management database having information pulled from the Internet and comprising at least one of consumable part numbers, alternative consumable part numbers, and information for selecting a reseller (PIA web server and response to claim 11).

In regards to claim 22, Katz teaches wherein at least one of the server and the at least one computer peripheral device proactively generates a warning to a user at the personal computer comprising information on an upcoming issue regarding maintenance and operation of a selected computer peripheral device (page 8, para 103, and para "low ink").

In regards to claim 23, Katz teaches communicating information, but does not specifically mention that the information is transmitted over an extended data interface. The use of an extended data interface to transmit data was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Katz transferring information over an extended data interface, because this is a very effective means of transferring information and could be used if alternative means were not available.

In regards to claim 24, Katz teaches wherein the centralized management database is configured for interaction with a maintainer at the personal computer to enable determination of when to replace a consumable as well as at least one of what consumable to replace, alternative parts for the associated peripheral device, issue urgency, proactive warning of one or more next issues, computer peripheral device location, owner/contact information, computer peripheral device model information, and impending maintenance notification (see response to claim 22, PIA/PIA Web server).

Response to Arguments

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner